

REMARKS

Claims 1-28 are pending in the present application. Reconsideration of the pending claims is respectfully requested in view of the below comments.

I. Premature Final Rejection

Claims 1-28 were rejected for the first time pursuant to 35 U.S.C. §101 in the present final rejection. During a discussion on August 14, 2006, between the Examiner (Djenane M. Bayard) and Applicant's representative (Sanders N. Hillis, Reg. No. 45,712), it was agreed that these rejections represent new grounds of rejection and that Applicant is entitled to a non-final office action in which to respond to said rejections. "[S]econd or subsequent actions on the merits shall be final *except where the examiner introduces new grounds for rejection* that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement..." MPEP 706.07(a) (emphasis added) Claims 1-28 have not been amended, and the rejection is not based on information submitted in an information disclosure statement. Thus, Applicant respectfully requests withdrawal of the finality of the present final rejection pursuant to MPEP 706.07(e), and issuance of a non-final office action to allow Applicant the opportunity to respond to the new grounds of rejection that have been raised.

II. The 35 U.S.C. 112 first paragraph rejections

Claims 1-28 were rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the enablement requirement because the portion of Chapter 3, Chapter 12, and Chapter 28

(submitted as Exhibits C, D, and E in the office action response filed May 8, 2006) of the book entitled Netcentric and Client/Server Computing – A Practical Guide (hereafter referred to as "the Book") do not describe the subject matter contained in the claims in such a way as to enable one skilled in the art to make and use the claimed invention. Applicant respectfully traverses these rejections since the disclosure in the portion of Chapter 3, Chapter 12, and Chapter 28 do describe the limitations included in the claims as follows: (Note: the portion of Chapter 3, Chapter 12, and Chapter 28 of the Book were submitted with the office action response filed May 8, 2006, and were also cross-referenced to the pages of U.S. Provisional Application Serial No. 60/156,962 on October 1, 1999 therein, thus the portion of Chapter 3, Chapter 12, and Chapter 28 are not resubmitted herewith.)

Applicant respectfully asserts that the limitations of Claims 1-28 are fully enabled and described in at least Exhibit 6 figure (corresponds to FIG. 1 of the present application) on page 3-15 of Chapter 3 of the Book, Exhibit 8 figure (corresponds to FIG. 2 of the present application) on page 3-18 of Chapter 3, pages 3-14 through 3-17 of Chapter 3 of the Book, Exhibit 1 figure (corresponds to FIG. 3 of the present application) on page 12-3 of Chapter 12 of the Book, and pages 12-2 through 12-22 of Chapter 12 of the Book.

Accordingly, Applicant respectfully traverses the assertions on page 2 of the office action mailed August 2, 2006 that the limitations described in Claims 1-28 are "merely a listing of tools," since as described above, the limitations are described in detail in at least the above-recited pages of the portion of Chapter 3, Chapter 12, and Chapter 28 of the Book. In addition, Applicant has submitted a Declaration from the inventors indicating that "each and every feature of the invention disclosed in Claims 1-28 ... are supported by and based on the Book." (See item

6 of the declaration filed as Exhibit A in the office action response filed May 8, 2006) Thus, Applicant has established with overwhelming facts and associated declaration Evidence that the claims are enabled by the Book and specifically, the above cited pages of the portion of Chapter 3, Chapter 12, and Chapter 28 of the Book.

It is the Examiner's burden to establish a reasonable basis for why the scope of protection provided by the claims is not enabled by the disclosure. (MPEP 2164.04) Applicant respectfully asserts that this burden has not been met and the assertions on page 2 of the office action mailed August 2, 2006 "that the evidence presented failed to provide a detailed description" has been traversed by the above-described recitation of the pages of support in the portion of Chapter 3, Chapter 12, and Chapter 28 of the Book. Further, Applicant respectfully traverses the assertion on page 2 of the office action mailed August 2, 2006, that "the Evidence presented failed to provide any improvement to the tools already known in the art" since reference to only two of a plurality of limitations described in Claims 1-28 are referenced, and no support for such an assertion has been provided with regards to the remaining limitations described in Claims 1-28. Applicant also respectfully asserts that such an assertion does not relate to nor satisfy the Examiner's burden with respect to establishing a reasonable basis to question the enablement provided for the claimed invention. (See MPEP 2164.04)

III. The 35 U.S.C. §101 Rejections

Claims 1-28 have been rejected as failing to comply with 35 U.S.C. §101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. Despite the previously described grounds for a premature final rejection,

Applicant herewith submits the following remarks while preserving the right to respond to the present rejections in a non-final office action.

Each of independent Claims 1, 19 and 24 describe a server and a client. In addition, Claim 1 describes a plurality of tools that include a help desk tool adapted to measure the performance of support personnel supporting said server and said client in a netcentric computing system. Claim 19 describes a plurality of tools, such as a security tool that includes a security application that provides security to said netcentric computing system, said security tool configured to limit access of said client to said server based on role based access control. The method of Claim 24 describes a plurality of steps that include monitoring performance of support personnel helping users encountering problems, said performance being measured by the number of users helped per a time period.

"Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. §101." MPEP 2106(II)(A) Applicant respectfully asserts that the burden to establish a *prima facie* case has not been met in the office action mailed August 2, 2006. In addition, Applicant has provided examples from the pending claims that clearly describe limitations with practical application in the technological arts.

"The subject matter courts have found to be outside the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena.... These three

exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable." MPEP 2106(IV)(A) Clearly, Claims 1-28 describe a practical application.

In the office action mailed August 2, 2006, it was apparently asserted that nonfunctional descriptive material was claimed. Applicant respectfully traverses these assertions based on at least the above-described limitations included in the Claims. "Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. §101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided." MPEP 2106(IV)(B)(1)(b) Clearly, each of the presently pending claims, when considered as a whole, describes material that exhibits a functional interrelationship with respect to a client and a server, and thus a 35 U.S.C. §101 rejection is not applicable and should be withdrawn.

In addition, in item 6 on page 3 of the office action mailed August 2, 2006, it was asserted that "information is missing about many essential part (sic) or relationships between parts," and "[a] vague description of software tools already known to one with ordinary skill in the art does not provide any tangible result." Applicant respectfully traverses the assertion that any information is missing from the portion of Chapter 3, Chapter 12, and Chapter 28, or the present application. As previously discussed, each and every limitation is described in detail in the pages of the portion of Chapter 3, Chapter 12, and Chapter 28 recited herein, and in the present application. Further, if any information is missing about "many essential part (sic) or

relationships between parts" as has been asserted, Applicant respectfully contends that "the examiner should specifically identify what information is missing, and why the missing information is needed to provide enablement" (MPEP 2164.06(a)) to allow the Applicant the opportunity to respond to the specific issues identified.

Applicant also respectfully traverses the assertion that the software tools are "already known." On pages 2 and 3 of the office action mailed August 2, 2006 a factual assertion is put forth that the limitations described in Claims 1-28 are well known software tools. This factual assertion has apparently not been officially noticed, and Applicant respectfully submits that such a factual assertion cannot be based on common knowledge as evidenced by the lack of any such teaching or suggestion in the prior art. If official notice is being taken, Applicant respectfully requests, pursuant to MPEP 2144.03(c), and to clarify issues for appeal, that adequate evidence be provided to support such factual findings. In addition, or alternatively, because the office action asserts facts that are not well known, and lack support in the prior art, Applicant respectfully requests an affidavit from the Examiner to support these assertions. See 37 C.F.R. 1.104(d)(2).

III. Rejections under 35 U.S.C. § 102(e)

The Office Action mailed August 2, 2006 maintained the rejection of claims 1-28 under 35 U.S.C. § 102(e) as anticipated by Guheen *et al.* (U.S. Patent Publication No. 2004/0107125). Since the Book was published on December 18, 1998 (see item 3 of the declaration filed as Exhibit A in the office action response filed May 8, 2006), which is prior to the earliest effective filing date of Guheen, Guheen is not prior art to the present application.

Response to Non-Final Office Action

Mailed August 2, 2006

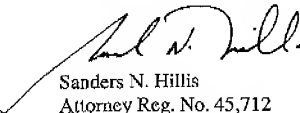
Response dated September 29, 2006

In the office action mailed January 9, 2006, the declarations filed in the request for continued examination (RCE) filed on November 16, 2005 were objected to as ineffective to overcome the Guheen reference because of a lack of a clear explanation of the facts provided in the declarations. In the response filed May 8, 2006 Applicant provided a clear explanation of the facts and the declarations are now effective to overcome the Guheen reference as evidenced by the withdrawal of the ineffective related objections in the office action mailed August 2, 2006. Accordingly, Guheen does not qualify as prior art under 35 U.S.C. § 102(e) and should be removed from consideration.

Conclusion

With this response, the present pending claims of this application are now allowable, and Applicant respectfully requests the Examiner to issue a Notice of Allowance for this application. Should the Examiner deem a telephone conference to be beneficial in expediting allowance/examination of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,



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SNH/dlh

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